

I. REMARKS:

A. Status of the Claims

Claims 1-9 were originally filed with the case. Claim 1 was amended in response to an Official Action mailed May 20, 2004. Claims 1, 3, and 5-8 were amended and claim 4 was canceled in response to an Official Action mailed January 7, 2005. No claims are amended, added or canceled herein. Claims 1-3 and 5-9 remain pending.

B. The Claims are Patentable Over Kalgutkar

The Action rejects claim 1 as being anticipated by Kalgutkar (U.S. Patent No. 6,207,700). Kalgutkar is said to disclose the compounds included in the claimed formula are useful to treat angiogenesis-related disorders. Applicants respectfully traverse.

The present invention is directed to a method of treating an ophthalmic angiogenesis-related disorder by administering a therapeutically effective amount of 3-benzoylphenylacetic acid, or a derivative thereof having the described formula. Kalgutkar discusses the use of certain secondary amides of certain NSAIDs to treat cancer. There is no discussion or suggestion within Kalgutkar to use the described secondary amides to treat ophthalmic angiogenesis-related disorders. The Final Action maintains the previously stated rejection based on Kalgutkar, stating only that "Kalgutkar discloses the instant amide compounds." The Final Action fails to address the fact that Kalgutkar fails to recite an important element of the claimed invention; that is, that it is directed to the treatment of ophthalmic angiogenesis-related disorders.

It is well settled that for a prior art reference to render a claim anticipated, that reference must set forth every element in the claim, either expressly or inherently. *Verdegaal Bros., Inc. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051 (Fed. Cir. 1987) (citing *Connell*

v. Sears, Roebuck & Co., 722 F.2d 1542, 1548, 220 U.S.P.Q. 193, 198 (Fed. Cir. 1983)). In other words, to support a rejection under section 102, a reference must show *all* features of the rejected claim(s). *Minnesota Mining & Mfg. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 1569, 24 USPQ2d 1321 (Fed. Cir. 1992). The Federal Circuit has stated that "absence of a claim element from a prior art reference negates anticipation." *Atlas Powder Co. v. E.I. du Pont de Nemours & Co.*, 224 U.S.P.Q. 409 (Fed. Cir. 1984).

In light of the fact that Kalgutkar does not discuss the treatment of ophthalmic angiogenesis-related disorders, it is submitted that Kalgutkar cannot anticipate the claimed invention. Therefore, Applicants respectfully request that the anticipation rejection based on Kalgutkar be withdrawn.

**C. The Claims are Patentable Over Bayly
 Or Kalgutkar in view of Hellberg**

Next, the Action rejects all claims as being unpatentable over Bayly (U.S. Patent No. 5,994,379) or Kalgutkar in view of Hellberg (U.S. Patent 6,342,524). Bayly is said to disclose that diabetic retinopathy and tumor angiogenesis are cyclooxygenase-mediated proliferative disorders and to further disclose the recited routes of administration. Kalgutkar is said to disclose that COX-2 inhibitors are antiangiogenic and antitumorigenic. The Action acknowledges that the claimed invention differs over Bayly and Kalgutkar in reciting a compound that is a derivative of the compounds disclosed in Kalgutkar. Hellberg is said to disclose that the recited compounds are COX inhibitors and to further disclose ophthalmic administration. Applicants respectfully traverse.

Applicants reiterate previously stated arguments that Hellberg discusses the use of certain compounds to treat GLC1A glaucoma and does not discuss the administration of derivatives of 3-benzoylphenylacetic acid to treat angiogenesis-related disorders. In fact, Hellberg discusses the

use of such compounds only in combination with a prostaglandin for the treatment of GLC1A glaucoma. Hellberg does not discuss the use of derivatives of 3-benzoylphenylacetic acid by themselves to treat angiogenesis-related disorders.

Moreover, the compounds disclosed in Bayly differ vastly from the compounds for use in the methods of the present invention. There is no suggestion within Bayly to modify the compounds described therein for use in treating a COX-2 mediated disease. As stated above, Kalgutkar contains no teaching or suggestion of the use of the compounds of the present invention for the treatment of ophthalmic angiogenesis-related disorders. Rather, Kalgutkar focuses only on the treatment of cancer. The present invention is the first to show that nepafenac and related compounds can be used to treat an ophthalmic angiogenesis-related disorder. Thus, Bayly and Kalgutkar cannot render the claimed invention obvious, either alone or in combination.

There is no suggestion or motivation within Hellberg to administer the compounds of the present invention by themselves for the sole purpose of treating angiogenesis-related disorders. As explained above, the focus of the invention of Hellberg is to lower IOP by administering a combination of compounds. The remainder of the description of the problem and the solution provided in Hellberg focuses on the increase of ocular hypertension caused by glucocorticoid induction of the GLC1A protein. This is what Hellberg seeks to treat. Furthermore, there is no motivation found within Hellberg, Bayly or Kalgutkar to combine the teachings therein.

In light of the foregoing arguments, Applicants respectfully request that the obviousness rejection based on Hellberg in combination with Bayly or Kalgutkar be withdrawn.

**D. The Double Patenting Rejections Will be
Overcome with Terminal Disclaimers When Appropriate**

Next, the Action provisionally rejects claims 1-9 under the judicially created doctrine of obviousness-type double patenting doctrine as being unpatentable over copending Application Nos. 10/344,881 and 10/417,466. The Action points out that these rejections are provisional, in that the copending applications have not yet been allowed. Applicants will file terminal disclaimers to overcome these provisional rejections upon a notice of allowability of the presently pending claims.

E. Conclusion

This is submitted to be a complete response to the outstanding Action. Based on the foregoing arguments, the claims are believed to be in condition for allowance; a notice of allowability is therefore respectfully requested.

The Examiner is invited to contact the undersigned attorney at (817) 551-4321 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,



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